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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,778	09/14/2000	MOTOSHI KISHI	106856	1551

25944 7590 10/16/2003

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 10/16/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/661,778

Applicant(s)
Kishi et al.

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 2, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Sep 19, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. The amendment filed July 22, 2003 has been entered.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 19, 2002 (paper no. 11) have been **approved**. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 8, the recitation "on the sheet" is vague as to what is being set forth, and it is suggested in line 8 to delete ", on the sheet", and to insert --on the sheet-- in line 6 after the third occurrence of "cutting", and in line 7 after the second occurrence of "cutting"; in line 11, structural cooperation is not positively set forth for the controller, particularly with respect to the drive unit, and it is suggested to change "that controls" to --coupled to the drive unit to control-- or the like.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Frisby et al.,
pn 4,608,891.

Frisby discloses an apparatus with every structural limitation of the claimed invention including a cutter comprising a cutting blade (e.g., 4); a switching device (e.g., 86 and the structure on which it vertically moves as described in column 4, lines 19-23); drive means (e.g., the means for moving feature 86 vertically along its support structure); and a controller (e.g., 76) that controls the drive unit.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gerber et al.,
pn 4,391,168 (hereafter Gerber '168).

Gerber '168 discloses an apparatus with every structural limitation of the claimed invention including a cutter comprising a cutting blade (e.g., 12); a switching device (e.g., 42, 44); drive means (e.g., the disclosed power source including 58); and a controller (e.g., 18) that controls the drive unit.

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7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pilkington, pn 4,920,495.

Pilkington discloses an apparatus with every structural limitation of the claimed invention including a cutter comprising a cutting blade (e.g., 54); a switching device (e.g., the structure on which the blade is movably supported); drive means (e.g., 46); and a controller (e.g., 58, 60) that controls the drive unit.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frisby et al., pn 4,608,891.

Frisby discloses an apparatus with almost every structural limitation of the claimed invention but lacks the specific switching device configuration. However, the Examiner takes Official notice that switching devices having such a configuration are old and well known in the art and provide various known benefits including facilitating quick and easy tool positioning to different modes such as a cutting position mode, a ready position mode and a tool change/maintenance mode. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a switching device on the apparatus of Frisby for the well known benefits including those described above.

10. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber et al., pn 4,391,168 (hereafter Gerber '168).

Gerber '168 discloses an apparatus with almost every structural limitation of the claimed invention but lacks the specific switching device configuration. However, the Examiner takes Official notice that switching devices having such a configuration are old and well known in the art and provide various known benefits including facilitating quick and easy tool positioning to different modes such as a cutting position mode, a ready position mode and a tool change/maintenance mode. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a switching device on the apparatus of Gerber '168 for the well known benefits including those described above.

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11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilkington, pn 4,920,495.

Pilkington discloses an apparatus with almost every structural limitation of the claimed invention but lacks the specific switching device configuration. However, the Examiner takes Official notice that switching devices having such a configuration are old and well known in the art and provide various known benefits including facilitating quick and easy tool positioning to different modes such as a cutting position mode, a ready position mode and a tool change/maintenance mode. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a switching device on the apparatus of Pilkington for the well known benefits including those described above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers Technology Center 3700 are: after-final responses - (703)872-9303; other formal/official papers - (703)872-9302. The fax number for informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
October 10, 2003